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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,182	04/09/2004	Robert N. Hamlin	10527-003008	1770

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EXAMINER	
WOLLSCHLAGER, JEFFREY MICHAEL	
ART UNIT	PAPER NUMBER
1791	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/822,182	HAMLIN, ROBERT N.	
	Examiner	Art Unit	
	Jeff Wollschlager	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-29,32 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-29, 32 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's amendment to the claims filed September 6, 2007 has been entered. Claim 26 is currently amended. Claims 1-25, 30 and 31 have been canceled.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 07/411,649, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The '649 application does not provide support for a first layer comprising a first polymeric material including a liquid crystal polymer as recited in independent claim 26. Support for a liquid crystal polymer as recited in claim 26 is found in U.S. Patent 5,270,086, filed July 9, 1991. Accordingly, the claims in the instant application are afforded a priority date of July 9, 1991.

Terminal Disclaimer

The terminal disclaimer filed on January 12, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent that issued from U.S. Patent Application 10/839,687 has been reviewed and is NOT accepted. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because: The terminal disclaimer was not signed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-29, 32 and 33 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26-30, 33, and 34 of copending Application No. 10/839,687 in view of Kingsford (U.S. Patent 4,799,717; issued January 24, 1989).

Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant claims and the claims found in application 10/839,687 are directed to

similar method steps. The differences between the claims are the polymeric materials employed as the first layer in producing a laminated expander member. In instant claim 26, the first layer comprises a liquid crystal polymer. In application 10/839,687, claim 26, the first layer comprises polyetheretherketone or polyetherketone. Liquid crystal polymers, polyetheretherketone and polyetherketone are known to be interchangeable in applications requiring high strength and temperature capabilities while remaining deformable/flexible as evidenced by Kingsford (Abstract; col. 5, lines 23-29). Therefore it would have been obvious to one having ordinary skill to interchange the polymers as is routinely practiced in the art.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 26-29, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (U.S. Patent 5,195,969) in view of Walder et al. (US 4,976,697).

Regarding claim 26, Wang et al. teach a method of producing a co-extruded medical balloon/expander and catheter comprising a plurality of layers wherein the outer layer is a material such as polyamide/nylon to provide burst strength and the inner layer is an adhesive layer (Abstract; col. 1, lines 44-col. 2, line 65; col. 5, lines 46-col. 6, line 9). Wang et al. do not disclose the outer layer is a liquid crystal polymer. However, Walder et al. teach that polyamide

and liquid crystal polymers are known to be suitable equivalents in medical catheters where stiffness and flexibility are simultaneously required (col. 2, lines 44-57).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have modified the method of Wang et al. by employing a liquid crystal polymer as the outer layer to replace the polyamide/nylon outer layer since Walder et al. disclose that polyamides and liquid crystal polymers are equivalent alternative plastic materials known in the art to be suitable for medical applications requiring simultaneous stiffness and flexibility (MPEP 2144.06-2144.07).

As to claim 27, Wang et al. disclose coextruding layers on both sides of the base structure (col. 1, lines 44-col. 2, line 29). The examiner asserts that the polyethylene material employed as the third layer enhances the lubricity since the coefficient of friction of polyethylene is lower than the coefficient of friction of polyetheretherketone, polyethylene terephthalate or nylon.

As to claims 28 and 33, Wang et al. biaxially orient the first layer and draw and expand the material in a blow mold (col. 5, lines 46-col. 6, line 8).

As to claim 29, Walder et al. disclose liquid crystal polymer as set forth above.

As to claim 32, the combination employs the same claimed process and the same claimed materials. Accordingly, the same claimed physical properties and effects would intrinsically be realized by the practice of the combination the same claimed process steps with the same claimed materials under the same claimed conditions. Accordingly, the expander member has the same claimed physical properties and effects.

Response to Arguments

Applicant's arguments filed September 6, 2007 have been fully considered, but are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager
Examiner
Art Unit 1791

CHRISTINA JOHNSON
SUPERVISORY PATENT EXAMINER

November 13, 2007